

**Remarks/Arguments**

**A. Pending Claims**

Claims 36, 51, and 61 have been amended. Claims 46, 65, 66, and 73-75 have been cancelled. Claims 76-78 have been added. Claims 36-45, 47-58, 60-64, 67-72, and 76-78 are pending in the case.

**B. Double Patenting**

The Examiner objected to claims 73-75 as being a substantial duplicate of claims 71 and 72. Applicant has cancelled claims 73-75.

**C. The Claims Are Not Indefinite Pursuant to 35 U.S.C. §112, Second Paragraph**

The Examiner rejected claims 51-58 and 60-75 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Office Action states: “there is no functional relationship of the flattening step to the determining step...” However, “it is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result.” *Ex parte Nolden*, 149 U.S.P.Q. 378, 380 (Bd. Pat. App. and Intf. 1965). Moreover, a claim does not necessarily fail to comply with 35 U.S.C. §112, second paragraph because the various elements “do not function simultaneously, are not directly functionally related, do not directly intercooperate, and/or serve independent purposes.” *Ex parte Huber*, 148 U.S.P.Q. 447, 448-49 (Bd. Pat. App. and Intf. 1965). Applicant respectfully disagrees that claims 51-58 and 60-75 are indefinite, but Applicant has amended claims 51 and

61 for clarification. Applicant respectfully requests removal of the rejection of claims 51, 61, and the claims dependent thereon.

**D. The Claims Are Not Obvious Over McDonough In View of Williams Pursuant To 35 U.S.C. § 103(a)**

The Examiner rejected claims 36-70 under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,115,693 to McDonough et al. (hereinafter “McDonough”) and further in view of U.S. Patent No. 6,591,272 to Williams (hereinafter “Williams”) and further in view of certain official notice taken by the Examiner concerning “modern database management.”

To reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner*, 154 U.S.P.Q. 173, 177-78 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974); MPEP § 2143.03. In addition, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 36 has been amended to describe a combination of features, including but not limited to: “the domain file comprising a plurality of serialized files generated by the domain manager from a domain source file, the domain source file comprising source definitions for a plurality of domains required by the system to process the business transaction, wherein each of the plurality of serialized files comprises a list of allowable values of a domain associated with one or more business transactions.” Support for the amendments to claim 36 may be found in Applicant’s specification at least on page 15, lines 4-11 and 21-28. The cited art does not appear to teach or suggest at least these features of claim 36, in combination with the other features of the claim.

Regarding now-cancelled claim 46 , the Office Action apparently took the position that “at least one serialized file generated by the domain manager” is “an inherent feature of the CORBA used for distributed computing and object messaging.” Applicant respectfully disagrees that a serialized file generated by a domain manager is inherent in the cited art. To rely on the theory of inherency, the examiner must “provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original.) Inherency may not be established by probabilities or possibilities; the mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). CORBA does not appear to require a serialized file generated by a domain manager. In any event, McDonough, Williams, and the other cited art, taken alone or in combination, do not appear to teach or suggest a middleware program comprising a domain file, the domain file comprising a plurality of serialized files generated by a domain manager from a domain source file, the domain source file comprising source definitions for a plurality of domains required by the system to process the business transaction, wherein each of the plurality of serialized files comprises a list of allowable values of a domain associated with one or more business transactions, in combination with the other features of claim 36.

For at least the reasons stated above, Applicant submits that claim 36 is allowable over the cited art. Applicant respectfully requests removal of the rejections of claim 36 and the claims dependent thereon.

Amended claim 51 recites: “wherein the serialized file is one of a plurality of serialized files in a domain file generated by a domain manager from a domain source file, the domain source file comprising source definitions for a plurality of domains required by a system to process a business transaction, wherein each of the plurality of serialized files comprises a list of allowable values of a domain associated with one or more business transactions”. For reasons similar to those set forth above with respect to claim 36, Applicant submits that the cited art does

teach or suggest at least this feature of claim 51, in combination with the other features of the claim.

Amended claim 61 recites: “the domain file comprising a plurality of serialized files generated by a domain manager from a domain source file, the domain source file comprising source definitions for a plurality of domains required by the computer system to perform the business transaction, wherein each of the plurality of serialized files comprises a list of allowable values of a domain associated with one or more business transactions”. For reasons similar to those set forth above with respect to claim 36, Applicant submits that the cited art does not teach or suggest at least this feature of claim 61, in combination with the other features of the claim.

**E. New Claims**

New claims 76-78 recite: “wherein the middleware program overrides an order of data of an object model with an order of data required by the business transaction server before transferring the data to the business transaction server.” Support for the new claims may be found in Applicant’s specification at least on page 16, lines 16-18. The cited art does not appear to teach or suggest at least this feature of claims 76-78, in combination with the other features of the claims.

**F. Additional Remarks**

Applicant submits that all claims are in condition for allowance. Favorable consideration is respectfully requested.

If an extension of time is needed, Applicant requests the appropriate extension of time. A fee authorization is enclosed for additional claims fees. If any other fees are required, please charge those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account Number 50-1505/5053-30700/EBM.

Respectfully submitted,



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